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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/933,133	08/21/2001	William Damian Hogan	4009-3	4946

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EXAMINER

ANWAH, OLISA

ART UNIT PAPER NUMBER

2614

DATE MAILED: 09/01/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/933,133

Applicant(s)

HOGAN ET AL.

Examiner

Olisa Anwah

Art Unit

2614

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 August 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) 2, 5, 11, 13, 23-26, 29, 33 and 42 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1,4,6-10,12,14,16-22,27,28,30-32,35-41 and 44-49 is/are allowed.
- 6) ☒ Claim(s) 3,15,34 and 43 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

Art Unit: 2614

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102(e)***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claim 34 is rejected under 35 U.S.C. § 102(e) as being anticipated by Monroe, U.S. Patent No. 2002/0111166 (hereinafter Monroe).

Regarding claim 34, Monroe discloses an apparatus for use in a mobile radio terminal, comprising:

radio transceiving circuitry configured to receive from a radio access network information indicating a list of one or more geographic coverage areas from which the mobile radio terminal may not obtain service, and

Art Unit: 2614

electronic circuitry configured to perform the following tasks:

check the stored list prior to determining whether to perform a geographic coverage area update, and

determine not to perform a geographic coverage area update based on the checked list in order to reduce signaling between the mobile radio terminal and the radio access network, wherein the information is received in a location area update rejection message in response to a location area update request message sent by the mobile terminal to the radio access network (see Figures 2-4).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 3, 15 and 43 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Monroe in view of Rune, U.S. Patent No. 6,212,390 (hereinafter Rune).

Art Unit: 2614

Regarding claim 3, Monroe discloses a method implemented in a mobile radio terminal for reducing signaling associated with the mobile radio terminal selecting a new geographic coverage area, comprising:

in response to a location area update request message sent by the mobile radio terminal to a radio access network, receiving from the radio access network a location update rejection message including information indicating a list of one or more location areas from which the mobile radio terminal may not obtain service;

storing the list of one or more geographic coverage areas;

checking the received information when considering whether to request service from a new geographic coverage area including checking the stored list prior to performing a subsequent geographic coverage area update; and

determining whether to select a geographic coverage area depending on the received information including determining whether to perform a location area update procedure based on the checked list (see Figures 2-4).

With further respect to claim 3, Monroe does not teach the list includes two or more location areas. All the same, Rune discloses this limitation (see list from column 10). And so, it

Art Unit: 2614

would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Monroe with the list of two or more location areas taught by Rune. This modification would have improved the efficiency of Monroe by minimizing processing costs for mobile devices that are not authorized to communicate within the network as suggested by Monroe (see paragraph 0048).

Regarding claim 15, Monroe discloses a method implemented in a cellular communications system including a radio access network for serving plural location areas, comprising:

receiving a geographic coverage area update request message from a mobile radio terminal, and

in response to the received geographic coverage area update request message, sending in a geographic coverage area update reject message to the mobile radio terminal information indicating a list of one or more location areas from which the mobile radio terminal may not request service,

wherein the mobile terminal uses the information to reduce signaling between the mobile terminal and the radio access network by not performing a location area update procedure for a location area including in the list.

Art Unit: 2614

With further respect to claim 15, Monroe does not teach the list includes two or more location areas. All the same, Rune discloses this limitation (see list from column 10). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Monroe with the list of two or more location areas taught by Rune. This modification would have improved the efficiency of Monroe by minimizing processing costs for mobile devices that are not authorized to communicate within the network as suggested by Monroe (see paragraph 0048).

Regarding claim 43, Monroe discloses radio access network apparatus for use in a cellular communications system including a radio access network serving plural geographic coverage areas, comprising:

radio transceiving circuitry configured to receive a message from a mobile radio terminal, and

data processing circuitry configured to provide information indicating a list of one or more geographic coverage areas from which the mobile terminal may not request service,

wherein the mobile radio terminal uses the information to reduce signaling between the mobile radio terminal and the radio access network by not performing a geographic coverage area

Art Unit: 2614

update procedure for a geographic coverage area included in the list (see Figures 2-4).

With further respect to claim 43, Monroe does not teach the list includes two or more location areas. All the same, Rune discloses this limitation (see list from column 10). And so, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Monroe with the list of two or more location areas taught by Rune. This modification would have improved the efficiency of Monroe by minimizing processing costs for mobile devices that are not authorized to communicate within the network as suggested by Monroe (see paragraph 0048).

#### ***Response to Arguments***

5. Applicant's arguments have been considered but are deemed to be moot in view of the new grounds of rejection.

#### ***Allowable Subject Matter***

6. While Monroe teaches receiving from the radio access network a location update accept message (see the private network sends an acceptance response to the mobile device from paragraph 0047), Monroe fails to teach the location update



Art Unit: 2614

accept message includes information indicating a list of one or more geographic coverage areas from which the mobile radio terminal may not obtain service.

### **Conclusion**

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Olisa

Art Unit: 2614

Anwah whose telephone number is 571-272-7533. The examiner can normally be reached on Monday to Friday from 8.30 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang can be reached on 571-272-7547. The fax phone numbers for the organization where this application or proceeding is assigned are 571-273-8300 for regular communications and 571-273-8300 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-2600.

O. A.

Olisa Anwah  
Patent Examiner  
August 29, 2006

  
FAN TSANG  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600